



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,455	02/26/2004	Kevin Morrison	020375-043010	5172
20350	7590	03/01/2006	EXAMINER	
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			LABAZE, EDWYN	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 03/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

7N

Office Action Summary	Application No. 10/789,455	Applicant(s) MORRISON ET AL.	
	Examiner EDWYN LABAZE	Art Unit 2876	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-10,12-18,20-22 and 24-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-10,12-18,20-22 and 24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Receipt is acknowledged of amendments filed on 12/5/2005.
2. Claims 1, 3-10, 12-18, 20-22, and 24-27 are presented for examination.
3. This application claims the benefits of provisional application No. 60/520,432 filed on 11/14/2003.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 3-5, 7-10, 13, 15-18, 20-22, and 25-27 are rejected under 35 U.S.C. 102(e) as being anticipated by Goldstein et al. (US 2004/0069845).

Re claims 1, 10, 13, and 21: Goldstein et al. teaches transaction card fabrication control system and method, which includes which includes receiving at a host computer system a request from a purchaser to order a presentation instruments, wherein a presentation instrument comprises a physical device {herein Goldstein teaches a system wherein a customer may wish to purchase a bundle of gift cards} used to settle a financial transaction (page 2, paragraphs 009+); sending one or more files {i.e. application forms to redeem personal information from the requestor/purchaser and means of personalizing the card with a unique identifier printed/embossed on the card, wherein the identifier may be the name of customer/recipient, or text or graphics and the like} that are executable by a computer of the purchaser to produce one

Art Unit: 2876

or more corresponding display screens programmed to collect purchase information relating to the plurality of presentation instruments (page 3, paragraphs 0045+; page 6, paragraphs 000058-0060; page 9, paragraphs 0078+); receiving at the host computer system the purchase information from the purchaser, wherein the purchase information comprises a recipient information file {herein name of the customer to be printed on the card} and wherein the purchase information comprises an order for a plurality of presentation instruments that comprise gift cards, at least some of which have different values associated therewith {herein Goldstein teaches that a customer may order three different gift cards in \$ 10, \$50, and \$100 denominations from the same manufacturer} (page 5, paragraph 0057); and delivering {herein interpreted as shipping} the presentation instruments in accordance with the purchase information (page 3, paragraphs 0045-0048; page 5, paragraph 0057; page 6, paragraphs 0060+). Goldstein et al. further teaches a computer device {herein computer/controller 1, as shown in fig. # 1} (page 4, paragraph 0049+).

Re claim 3: Goldstein discloses a system and method, wherein delivering the presentation instruments in accordance with the purchase information comprises delivering {herein interpreted as shipping} the presentation instruments to each of a plurality of recipients (page 5, paragraph 0057; page 6, paragraph 0060).

Re claim 4: Goldstein et al. teaches a system and method, wherein delivering/shipping the presentation instruments in accordance with the purchase information comprises delivering the presentation instruments to the purchaser (page 5, paragraphs 0057+).

Re claim 5: Goldstein et al discloses a system and method, wherein delivering the presentation instruments in accordance with the purchase information comprises delivering the presentation instruments to a designee of the purchaser (page 7, paragraph 0065+).

Re claims 7, 18, and 25: Goldstein et al. discloses a system and method, wherein the recipient information file comprises a selection from the consisting of a spreadsheet, a text file, and a data file (page 9-10, paragraphs 0078-0079).

Re claims 8, 15, and 26: Goldstein et al. teaches a system and method, wherein the purchase information comprises a message to be embossed on each card (page 9-10, paragraphs 0078-0079).

Re claims 9, 16-17, and 27: Goldstein et al. discloses a system and method, purchase information comprises a recipient name to be embossed on each card (page 6, paragraph 0059).

Re claim 20: Goldstein et al. teaches a system and method, wherein the presentation instruments comprise non-personalized {herein Goldstein et al. discloses that the card production can be made at any suitable point in manufacturing, such as from the first processing steps or any point thereafter. For example, production of each card in a group may be tracked from initial assembly of printed sheets or other card parts, or after cards in the group are personalized} cards (page 3, paragraph 0045+).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 2876

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 6, 12, 14, and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldstein et al. (US 2004/0069845) in view of Cuervo et al. (US 2002/0174016).

The teachings of Goldstein et al. have been discussed above.

Goldstein et al. fails to teach means a request from a user to view usage information relating the card.

Cuervo et al. discloses multiple accounts and purposes card method and system, which includes means a request from a user to view usage information relating the card (see the abstract, which includes notification of timely usage of the card, amount charged and where was used. Another practical use involves the distribution to traveling salespersons authorizing geographical specific use, allowing others the use of same functions or others in the card in a different area).

In view of Cuervo et al.'s teachings, it would have been obvious to an artisan of ordinary skill in the art at the invention was made to employ into the teachings of Goldstein et al. a request from a user to view usage information relating the card so as to control/view the usage/amount of the stored value on the card. Furthermore, such modification would enable the customer to keep track of the remaining balance, usage of the card {such as when, where, how the card has been used} in order to prevent fraudulent activities.

Another advantage of viewing the usage of the card is to replenish the amount if necessary, such method is also employed in the credit/debit card application {wherein some parents would purchase or prepaid a card for their college kids and monitor the usage and/or transactions so as to replenish/add money/funds onto the card into to permit the continuing use of

Art Unit: 2876

the card}, wherein the customer/purchaser can track/monitor the usage of the card. Moreover, such modification would have been an obvious extension as taught by Goldstein et al., therefore an obvious expedient.

Response to Arguments

8. Applicant's arguments filed on 12/5/2005 have been fully considered but they are not persuasive.

The applicant argues that the prior art, Goldstein (US 2002/0174016), fails to teach how the orders are placed, and does not anticipate "sending one or more files that are executable by a computer of the purchaser to produce one or more corresponding display screens programmed to collect purchase information relating to the plurality of presentation instruments, and application forms" (see page 9, 4th & 5th paragraphs of applicant's arguments).

The examiner respectfully disagrees with the applicant's remarks and would like to point out that the prior art of record does teach means of ordering bundle of cards in sequence suitable to a particular customer name and identifier printed on the card (paragraph 59), wherein the name of the customer is to be provided while ordering the cards. In fact, the prior art does teach inherently an application form permitting a customer to input information for ordering cards; therefore the examiner retains the rejection as set forth above.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Art Unit: 2876

Seidman et al. (U.S. 6,671,358) discloses method and system for rewarding use of a universal identifier, and/or conducting a financial transaction.

Dev et al. (US 2004/0054587) teaches system and method for managing private consumer accounts using branded loyalty cards and using self-service terminals.

Tuchler et al. (US 2004/0099730) discloses system and method of personalizing financial transactions cards.

Fiala et al. (US 2004/0139318) teaches activation and personalization of downloadable content.

Sturr, Jr. (US 2004/0143512) discloses method and system for placing an order.

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395.

The examiner can normally be reached on 7:30 AM - 4:00 PM.

Art Unit: 2876

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

el
Edwyn Labaze
Patent Examiner
Art Unit 2876



THIEN M. LE
PRIMARY EXAMINER